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EXAMINER

SHTERENGARTS, SAMANTHA L

ART UNIT

PAPER NUMBER

1626

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/527,948	Applicant(s) SEU-SALERNO ET AL.	
	Examiner Samantha L. Shterengarts	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 13-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/28/08, 3/6/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 13-18 are currently pending in the instant application.

Response to Amendment

2. Amendments filed March 6, 2009 are acknowledged.
3. All rejections not explicitly maintained herein are withdrawn.

Maintained Rejections

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. (US 5,645,903) in view of the teachings of Verdon et al. (US 5,063,050).

With respect to claim 13, Tanaka et al. discloses a cosmetic composition made up in whole or in part of a solid powder, the composition comprising a liquid phase (water) in encapsulated form or immobilized on the surface of a solid, a gelling agent (agar or gelatin) for the liquid phase and mineral or organic particles having surface properties that give the particles a low affinity for the liquid phase (col. 2, lines 41-49; col. 3, lines 26-49). Tanaka et al. fails to expressly disclose the

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cosmetic composition is in a powder form that is transformed into a cream upon application. However, Tanaka et al. does disclose the cosmetic composition is in a solid form which imparts a watery, fresh sensation when applied, and the solid composition can be used as a cream (col. 2, lines 41-59; col. 5, lines 26-29). It is well known in the art for pressed powders to impart a creamy texture when applied, as taught by Verdon et al. (col. 3, lines 45-47). It would have been obvious to one of ordinary skill in the art to modify the initial form of the solid composition to be a powder depending on the desired application (e.g. pressed powder).

Response to Arguments

Applicant's representative asserts that Tanaka et al. and Verdon et al. are not combinable because Tanaka relates to an oil-in-water emulsion composition and Verdon relates to a pressed powder composition. The motivation for one of ordinary skill in the art to combine these two references is that they are both cosmetic compositions whose components are serving the same purpose in both applications. Both Tanaka and Verdon have novelties aimed at solving the same problem, which is a cosmetic composition that overcomes the difficulties of makeup application. From Verdon, "The pressed tablets provide for a more facile use of the powdered cosmetic, that is, without any of the disadvantages resulting from the use of the cosmetic in loose powder form, e.g., messiness, loss of powder by spilling, and other known disadvantages" (col. 1, lines 8-12). From Tanaka, "cosmetic composition which imparts a fresh feel on use, exhibits good affinity to the skin, gives a natural make-up finish, possesses superior moisturizing properties, provides excellent ease of application, and is convenient to carry," (col. 1, lines 9-13). Both references are aimed at overcoming the difficulties of makeup application.

Furthermore, Applicant's representative writes the following:

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Tanaka does not teach or suggest, among other things, a cosmetic composition in a powder form that is transformed into a cream upon application.

Furthermore, Tanaka does not teach or suggest liquid phase encapsulated in or immobilized on the surface of a solid carrier, the solid carrier being dispersed in the powder or a component of the powder. Rather, Tanaka discloses an oil-in-water composition with "water oozing out from the aqueous-type solid composition." Column 5, lines 51-52. This is different from Applicants' claim 13. The Examiner concedes that Tanaka does not disclose a cosmetic composition in powder form that is transformed into a cream upon application. Office action at page 7, lines 9-10. Verdon fails to cure the deficiencies of Tanaka. Verdon does not teach or suggest, among other things, a liquid phase encapsulated in or immobilized on the surface of a solid carrier. Additionally, Verdon does not teach or suggest a gelling agent for a liquid phase, nor particles having surface properties that give the particles a low affinity for the liquid phase. Instead, Verdon teaches pressed powder products that provide a creamy texture, a moisturizing effect, and light sheer coverage. Column 3, lines 45-47. The compositions of Verdon are pressed powders with a firm consistency. Column 3, lines 20-26. Accordingly, Applicants respectfully submit that Tanaka and Verdon, taken alone or in combination, do not teach or suggest all the subject matter of amended independent claim 13.

Applicant's representative is correct that Tanaka fails to expressly disclose a cosmetic composition in a powder form that is transformed into a cream upon application. Examiner notes this on pages 7 of the Office action, and relies on Verdon to cure this deficiency, provided the motivation to combine these two references, as detailed above. The fact that the cosmetic composition is transformed into a cream upon application is an intended use and is not given patentable weight. If the prior art teaching the cosmetic composition discloses all components required, as claimed, it would most necessarily perform the same function, in this case, being transformed into a cream upon application.

Applicant's representative is incorrect that Tanaka does not teach or suggest a liquid phase encapsulated or immobilized on the surface of a solid carrier, the solid carrier being dispersed in the powder or a component of the powder. In col. 5, lines 50-55, Tanaka discloses, "This water absorbing material can solve the above-mentioned problem by absorbing water oozing out from

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the aqueous-type solid cosmetic composition and by increasing the adhesion strength between the cosmetic composition and the container." This disclosure is referring to the absorbing material being able to immobilize the water oozing out from the solid cosmetic composition, therefore, being functionally equivalent to the encapsulation or immobilization of the liquid phase on the surface of a solid carrier. It would have been obvious for one of ordinary skill in the art to modify the type of encapsulation or immobilization, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Finally, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant's representative points out that Verdon does not teach or suggest various limitations of the instant claims. This is correct, and Verdon does not need to teach these various limitations as Tanaka is the primary reference and teaches all of them. Verdon is solely relied upon to support the intended use that it is well known for pressed powders to impart a creamy texture when applied (col. 3, lines 45-47). Verdon and Tanaka have been combined for the motivation as detailed above.

Maintained Rejections

Claim Rejections - 35 USC § 103

5. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. (US 5,645,903) in view of the teachings of Verdon et al. (US 5,063,050) and further in view of Funatsu (US 5,622,693).

With respect to claim 14, the modified Tanaka et al. addresses all the limitations of claim 13, and further discloses the mineral particles comprise fluorinated titanium dioxide particles (Table 1). However, the modified Tanaka et al. fails to expressly disclose the gelling agent is a starch modified by carboxymethyl groups. It is well known in the art to use gelatin or carboxymethyl starch as a gelling agent in solid cosmetic compositions, as taught by Funatsu (col. 2, lines 21-56). Therefore, the carboxymethyl starch is considered to be functionally equivalent to the gelatin. It would have been obvious to one of ordinary skill in the art to modify the type of

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gelling agent used, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 16, the modified Tanaka et al. discloses the cosmetic composition is a water-based composition (col. 3, lines 19-20; col. 5, lines 18-20), and therefore is considered to remain an aqueous-based composition when applied.

Response to Arguments

There are no arguments directly related to dependent claims 14 and 16.

Maintained Rejections

Claim Rejections - 35 USC § 103

6. Claims 13, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kashimoto (US 2002/0012682) in view of Yamamoto (US 6,548,454) and further in view of the teachings of Verdon et al. (US 5,063,050).

With respect to claims 13, 15 and 17, Kashimoto discloses a cosmetic composition made up in whole or in part of a solid powder, the composition comprising a liquid phase (oil) in encapsulated form or immobilized on the surface of a solid, fluorinated mica, and mineral or organic particles having surface properties that give the particles a low affinity for the liquid phase (fluorinated titanium dioxide) (Example 1). While Kashimoto fails to expressly disclose the fluorinated mica being used as a gelling agent, however it is well known in the art for fluorinated mica to have that property, as evidenced by Yamamoto et al. (claim 1). Examiner further notes these ingredients are the same as that recited in applicant's specification, therefore are considered to have similar properties and functions, especially the fluorinated titanium dioxide being lipophobic (see pg. 11, 1st paragraph of applicant's specification). While Kashimoto fails to expressly disclose the cosmetic composition transforming from a powder into a cream, Kashimoto does disclose the cosmetic composition is a pressed powder (example 1). It is well known in the art that pressed powders impart a creamy texture when applied, as taught by Verdon et al. (col. 3, lines 45-47). Therefore, the cosmetic composition is considered to be transformed from a powder form into a cream upon application.

Response to Arguments

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Applicant's representative asserts that Kashimoto et al., Yamamoto et al., and Verdon et al. are not combinable because Kashimoto relates to pressed powder compositions, Yamamoto relates to a rolling apparatus with a prolonged torque life than can undergo rotary or linear motion, and Verdon relates to tableted powder cosmetics. Once again, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The motivation for one of ordinary skill in the art to combine Kashimoto and Verdon is that they are both cosmetic compositions whose components are serving the same purpose in both applications. Both Kashimoto and Verdon have novelties aimed at solving the same problem, which is a cosmetic composition that overcomes the difficulties of makeup application. From Verdon, "The pressed tablets provide for a more facile use of the powdered cosmetic, that is, without any of the disadvantages resulting from the use of the cosmetic in loose powder form, e.g., messiness, loss of powder by spilling, and other known disadvantages" (col. 1, lines 8-12). From Kashimoto, "An object of the present invention is therefore to provide a pressed powder cosmetic composition which has smooth and moisturized touch feeling, is excellent in felling upon use, for example, easy release of powder, and does not crack easily," (col. 1, [0008]). Both references are aimed at overcoming the difficulties of makeup application. Yamamoto et al., while not being drawn to a cosmetic composition, is once again, employed in solving the same problem, which employs a thickening agent for the same quoted purpose.

Furthermore, Applicant's representative writes the following:

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Kashimoto does not teach or suggest a composition in powder form that transforms into a cream upon application. The Examiner concedes this deficiency: "Kashimoto fails to expressly disclose the cosmetic composition transforming from a powder into cream." Office action at page 9, lines 7-9. Rather, Kashimoto discloses a "pressed powder cosmetic composition which has smooth and moisturized touch feeling." Paragraph [0008]. Further, Kashimoto does not teach or suggest a liquid phase encapsulated in or immobilized on the surface of a solid carrier. In fact, encapsulation or immobilization of a liquid phase on the surface of a solid is not disclosed anywhere in Kashimoto. In contrast to Applicant's claim 13, Kashimoto discloses a water-repellent and oil-repellent powder and a film-forming polymer. Paragraphs [0011]-[0012]. Furthermore, Kashimoto does not teach or suggest a gelling agent for a liquid phase. Rather, Kashimoto discloses a composition comprising a film-forming polymer having a modulus of elasticity. Claim 1. The Examiner asserts that the fluorine-treated mica of Kashimoto (Table 1) is a gelling agent. Applicants respectfully submit that the fluorine-treated mica of Kashimoto is used as a particle and that the composition includes no gelling agent. Applicants have claimed a cosmetic composition comprising a liquid phase and a powder, the powder comprising a gelling agent for the liquid phase and mineral or organic particles having surface properties that give the particles a low affinity for the liquid phase, wherein the liquid phase is encapsulated in or immobilized on the surface of a solid carrier, the solid carrier being dispersed in the powder or a component of the powder, and wherein the cosmetic composition is in a powder form that is transformed into a cream upon application. Applicants respectfully submit that it is improper for the Examiner to use the same component of Kashimoto (fluorine-treated mica) to read on multiple components of the Applicant's composition (particles and gelling agent).

Yamamoto does not cure the deficiencies of Kashimoto. Specifically, Yamamoto does not teach or suggest a cosmetic composition in a powder form that is transformed into a cream upon application. Rather, Yamamoto discloses a lubricant composition comprising a thickening agent and a base oil. Column 8, lines 36-40. Additionally, Yamamoto does not teach or suggest a liquid phase encapsulated in or immobilized on the surface of a solid carrier. Rather, Yamamoto discloses a lubricant composition that is a mixture of a thickening agent which is a fluoro-mica-based lamellar mineral particle or a mixture of said lamellar mineral particle and a solid fluoropolymer particle, and a base oil comprising a liquid fluorinated polymer oil. Claim 1.

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Verdon also fails to cure the deficiencies of Kashimoto and Yamamoto. Specifically, Verdon does not teach or suggest a gelling agent for the liquid phase, nor does Verdon teach or suggest a liquid phase encapsulated in or immobilized on the surface of a solid carrier. In contrast, Verdon discloses a pressed cosmetic powder composition formed from talc, a powdered lubricant, a powdered sorbent agent, and a liquid binder. Column 2, lines 9-17. Verdon discloses "pressed powder products, (that) when applied to the skin, provide a creamy texture, a moisturizing effect and a light sheer coverage." Column 3, lines 45-47. The composition of Verdon does not transform into a cream upon application. Hence, Kashimoto, Yamamoto and Verdon, taken separately or combined, do not teach or suggest all the subject matter of claim 13.

Applicant's representative is correct that Kashimoto fails to expressly disclose a cosmetic composition in a powder form that is transformed into a cream upon application. Examiner notes this on pages 9 of the Office action, and relies on Verdon to cure this deficiency, provided the motivation to combine these two references, as detailed above. The fact that the cosmetic composition is transformed into a cream upon application is an intended use and is not given patentable weight. If the prior art teaching the cosmetic composition discloses all components required, as claimed, it would most necessarily perform the same function, in this case, being transformed into a cream upon application. Once again, Kashimoto does disclose the cosmetic composition is a pressed powder (example 1). It is well known in the art that pressed powders impart a creamy texture when applied, as taught by Verdon et al. (col. 3, lines 45-47).

Further, Kashimoto does suggest a liquid phase encapsulated in or immobilized on the surface of a solid carrier. The film-forming polymer, found in example 1, Table 1, can conceivably form a film over the liquid phase (oil), further encapsulating or immobilizing the liquid phase on the surface of the solid carrier. This is one function of the film-forming polymer in the pressed powder composition.

Applicant's representative is correct that Kashimoto fails to expressly disclose the fluorinated mica being used as a gelling agent, Office action, page 9. However, it is well known in the art for fluorinated mica to have that property, as evidenced by Yamamoto (claim 1). Applicant's believe that Examiner has pointed to the same component of Kashimoto (fluorine-treated mica) to read

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on multiple components of Applicant's composition (particles and gelling agent). However, the fluorinated titanium dioxide of example 1 of Kashimoto read on the particles and the fluorinated mica reads on the gelling agent, modified by Yamamoto.

Applicant's representative points out that Yamamoto and Verdon do not teach or suggest various limitations of the instant claims. This is correct, and Yamamoto and Verdon do not need to teach these various limitations as Kashimoto is the primary reference and teaches most of them.

Yamamoto is solely relied upon to support the modification of fluorinated mica being used as a gelling agent, as it is well known in the art for fluorinated mica to have that property, as evidenced by Yamamoto et al. (claim 1). Verdon is solely relied upon to support the intended use that it is well known for pressed powders to impart a creamy texture when applied (col. 3, lines 45-47). These references have been combined for the motivation as detailed above.

Maintained Rejections

Claim Rejections - 35 USC § 103

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kashimoto (US 2002/0012682) in view of Yamamoto (US 6,548,454) and further in view of the teachings of Verdon et al. (US 5,063,050) and further in view of Ohno et al. (US 5,023,065).

With respect to claim 18, the modified Kashimoto addresses all the limitations of claims 13 and 17, however fails to expressly disclose the fluorinated mica being modified with potassium.

Ohno et al. teaches it is well known in the art to use a fluorinated mica modified with potassium in a powder foundation (Example 1). It would have been obvious to one of ordinary skill in the art to use the fluorinated mica modified with potassium of Ohno et al. in order to improve the extensibility, adherence and moldability of the cosmetics (col. 1, lines 18-20; col. 29, lines 37-46). Further, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Response to Arguments

There are no arguments directly related to dependent claim 18.

Conclusion

8. No claims are allowed.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samantha Shterengarts whose telephone number is (571)270-5316. The examiner can normally be reached on Monday thru Thursday 9-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

/Samantha L. Shterengarts/
Examiner, Art Unit 1626

/Kamal A Saeed/
Primary Examiner, Art Unit 1626